

App. No. 10/787,364
Attorney Docket 3040.2.2 NP

Remarks

With regards the substantive portion of the Written Restriction Requirement, Claims 1-20 are subject to an election requirement. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held allowable. The Office Action noted Figs 1, 5, 8, and 9 as distinct species. Examiner further noted that claims 1, 10, 11, and 12 are generic, and that upon allowance of a generic claim, Applicant will be entitled to consideration of claims to additional species.

Applicant provisionally elects, with traverse, the species disclosed in Figure 5. As requested, Applicant indicates that Claims 1-6 and 8-20 are readable on Figure 5 and should therefore be examined.

Applicant argues that restriction is improper between figures 1, 5, 8 and 9. MPEP §806.04(b) states that

[w]here inventions as disclosed and claimed are both (A) species under a claimed genus and (B) related, then the question of restriction must be determined by both the practice applicable to election of species and the practice applicable to other types of restrictions such as those covered in MPEP §806.05 - §806/05(i). If restriction is improper under either practice, it should not be required.

Examiner notes that claims 1, 10, 11, and 12 are generic to all species. Claims 1, 10, 11, and 12, therefore, claim a genus to which all species are encompassed, as required by (A) above.

MPEP §802.02 explains that the term "related" is synonymous with the term "dependant", that is, not independent. Independent inventions are inventions in which "there is no disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, operation, or effect." Figures 8

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and 9 depict species of locking mechanisms that are useable together with either of Figures 1 and 5. That is, the species of Figures 8 and 9 are not unconnected in design, operation or effect. Applicant argues, therefore, that Figures 8 and 9 are related to Figures 1 and 5. As stated above, related species under the same genus may only be subject to a restriction if Examiner looks both to the practice for the election of species and the practice applicable to other types of restrictions, such as, that the species are distinct. *See* MPEP §§ 806.05 – 806.05(i).

MPEP § 803 requires that either (1) the inventions be independent or distinct as claimed, and (2) there must be a serious burden on examiner. As stated above, Applicant argues that the species of Figures 8 and 9 are not independent from the species of Figures 1 and 5. Even if the species are independent, however, Examiner “must provide reasons and/or examples to support conclusions.” MPEP § 803. A *prima facie* case of serious burden on the examiner may be shown if the species are in separate classifications, separate status in the art, or a different field of search is required. MPEP § 803.

Examiner, however has made no arguments to support the conclusion that the species are independent, and has made no claim that the species are in separate classifications, have separate status in the art, or are of different fields of search. As a result, Examiner has failed to show that (1) the inventions are independent or distinct, and (2) a serious burden on the examiner. Because Examiner has failed to meet his required burden, Applicant respectfully traverses the restriction requirement between depicted species.

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Applicant also argues the indicated species not depict independent inventions (*i.e.* the species depicted are related). MPEP § 806.04 states that

[t]wo different combinations, not disclosed as capable of use together, having different modes of operation, different functions or different effects are independent. An article of apparel such as a shoe, and a locomotive bearing would be an example. A process of painting a house and a process of boring a well would be a second example.

Applicant argues that the depicted species have a non-different mode of operation, function and effect. Although the locking mechanism is depicted as being on a separate base in Figure 1 than it is in Figure 5, the mode of operation, function, and effect are similar. Indeed, the mode of operation, function, and effect are similar in all of the depicted species. The mode of operation, function and effect are to secure and lock a ladder to a vehicle, providing a certain amount of confidence that the ladder will be secured and locked to the vehicle and that the securing and locking the ladder is not a time consuming ordeal. See Paragraph 8, application. As stated above, related species under the same genus may only be subject to a restriction if Examiner looks both to the practice for the election of species and the practice applicable to other types of restrictions, namely that the species are distinct.

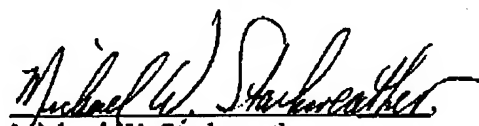
As stated above, Examiner has the burden to provide evidence for the conclusion that the inventions are independent or distinct, and make a *prima facie* showing of serious burden. Examiner, however, has given no reasons as to why the species are independent or distinct, and has not made any showing of a *prima facie* case of serious burden. Because Examiner has failed to meet his burden,

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Applicant respectfully traverses the restriction requirement between depicted species.

Should Examiner wish to discuss the election, Applicant invites the Examiner to do so by telephone conference.

Respectfully Submitted,



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Date: 6/24/05

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